

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Application of:**

Donald L. Morton,
Rishab K. Gupta and
David M. Euhus

Group Art Unit: 1642

Examiner: M. Davis

Atty. Dkt. No.: CADL:002/SLH

Serial No.: 07/431,533

Filed: November 3, 1989

For: URINARY TUMOR ASSOCIATED
ANTIGEN, ANTIGENIC SUBUNITS
AND METHODS OF DETECTION

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February 14, 2001

Date

Steven J. Highlander

COMMUNICATION AND SUPPLEMENT TO SUPPLEMENTAL BRIEF UNDER
37 C.F.R. §1.193(b)(2)(ii)

BOX AF

Hon. Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is a supplemental reply to the Office Action mailed on June 21, 2000. On February 8, 2001, Examiner Davis placed a call to the undersigned requesting filing of the terminal disclaimer that was to be included with appellants' supplemental brief, filed on November 21, 2000. Upon review of the relevant files, the following facts have come to the undersigned's attention, and thus occasion the instant submission.

FACTS

1. The obviousness-type double-patenting rejection over the claims of U.S. Serial No. 08/462,570 was first advanced in the Office Action mailed on August 5, 1998. It has been maintained in each of the two subsequent Office Actions.

2. In an Office Action mailed on April 28, 1998, a similar obviousness-type double-patenting rejection was advanced against the '570 application over the claims of the present application. In a response filed on August 21, 1998, all the pending claims of the '570 were canceled and new claims added. It was argued therein that the new claims provided in the August 21st response, and contemporaneous amendments to the present application's claims, obviated that rejection.

3. On April 2, 1999, the examiner in the '570 application withdrew the obviousness-type double-patenting rejection and allowed the case without further amendment.

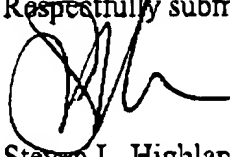
REMARKS

It is respectfully submitted that, *if the claims of the '570 application could be allowed over the claims of the present application, then there is no longer any conflict between these two cases.* In fact, the claims of the '570 application (now issued as U.S. Patent 5,993,828) are all drawn to *in vivo* stimulation of immune responses. All but one of the claims of the present application are drawn to compositions of matter, which clearly are patentably distinct from *in vivo* uses. Appellants hereby cancel the only other claim, claim 19, without prejudice or

disclaimer. As such, appellants respectfully request that the examiner reconsider and withdraw the obviousness-type double-patenting rejection now pending in the present application.

No fees are believed due in connection with this paper. However, should any fees be due, applicant authorizes the Assistant Commissioner to debit Fulbright & Jaworski Deposit Acct. No. 50-1212/10005391/SLH.

Respectfully submitted,



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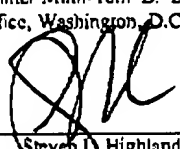
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